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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,743	10/14/2003	Haruhisa Masuda	1377-03	4044
35811	7590	08/26/2004	EXAMINER	
IP DEPARTMENT OF PIPER RUDNICK LLP ONE LIBERTY PLACE, SUITE 4900 1650 MARKET ST PHILADELPHIA, PA 19103			MIGGINS, MICHAEL C	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/684,743	Applicant(s) MASUDA ET AL.	
	Examiner Michael C. Miggins	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01122004</u> | 6) ☐ Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 1/12/2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. A black line has been placed through the 1449 herein. It is respectfully requested that applicant submit a new 1449 with a statement of relevance.

Claim Objections

2. Claims 8-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from another multiple dependent claim, claims 8-9 are ultimately dependent on claims 6 and 7 which are themselves multiple dependent claims. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al. (EP 1 197 699 A2) in view of Oka et al. (U.S. Patent No. 6,258,927 B1).

Claim 7 in its entirety recites a method limitation which does not structurally further limit the product claims 1 or 2 from which it depends. Thus the prior art need not teach applicant's method limitation to read on the claim as written (applies to instant claim 7).

Katayama et al. teach a multi-layer structure comprising two, three, or more layers including at least a layer (a) comprising (A) nylon 11 and/or nylon 12, and a layer (b) comprising (B) a polyamide resin (nylon 9T) consisting of a dicarboxylic acid component and a diamine component and a layer (c) comprising (A) nylon 11 and/or nylon 12 or (C) nylon 6, wherein said layer (a) comprising (A) nylon 11 and/or nylon 12 is the outermost layer, wherein said layer (c) comprising (A) nylon 11 and/or nylon 12 or (C) nylon 6 is the innermost layer, wherein said layer (b) comprising (B) nylon 9T is an intermediate layer (page 3, paragraph [0018]), wherein the innermost layer has electrical conductivity (since there is at least some electrical conductivity even though it is very low, see page 3, paragraph [0017]), wherein the multi-layered structure is selected from the group consisting of a film, a hose, a tube, a bottle and a tank (page 2, paragraph [0007]) and wherein the multi-layered structure is a tube or hose for fuel pipes of automobiles (page 2, paragraph [0007]) (applies to instant claims 1-9).

Katayama et al. disclose applicant's invention substantially as claimed. However, Katayama et al. fails disclose that the nylon 9T consists of 60 to 100 mol% of the dicarboxylic acid component being a terephthalic acid and 60 to 100 mol% of a diamine selected from 1,9-nonanediamine and 2-methyl-1,8-octanediamine.

Oka et al. disclose a nylon 9T composition which consists of 60 to 100 mol% of the dicarboxylic acid component being a terephthalic acid and 60 to 100 mol% of a diamine selected from 1,9-nonanediamine and 2-methyl-1,8-octanediamine (column 2, lines 35-61 and column 3, lines 27-67) wherein the composition is used in various components of machines, decorations, films, sheets and fibers (column 1, lines 15-20) for the purpose of providing flame retardancy, heat resistance, and good thermal stability (column 1, lines 55-65).

The references are analogous because both are drawn to films containing nylon 9T and the nylon 9T of Oka et al. provides flame retardancy, heat resistance, and good thermal stability.

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided nylon 9T which consists of 60 to 100 mol% of the dicarboxylic acid component being a terephthalic acid and 60 to 100 mol% of a diamine selected from 1,9-nonanediamine and 2-methyl-1,8-octanediamine in the multi-layer structure of Katayama et al. in order to provide flame retardancy, heat resistance, and good thermal stability as taught or suggested by Oka et al..

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (571) 272-1494. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCM
August 8, 2004

Michael C. Miggins
Examiner
Art Unit 1772

